

**REMARKS**

Claims 1-41 are pending in this application. Claims 1, 2 and 40 have been amended herein. It is noted that claim 2 has been amended to correct a minor grammatical error. Remarks regarding the Examiner's rejection of claims 1-20 and 40-41 are provided below.

The Examiner has rejected claims 1-20, 40 and 41 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

The Examiner asserted that the phrase "that opens the clamping jaw" is indefinite "since its unclear what particular structure is doing the openings." Although Applicants disagree, claims 1 and 40 have been amended to recite the "first direction being a direction the support element moves to allow the first clamping jaw to move away from a second clamping jaw." Such amendment is being made in an effort to bring the present application closer to allowance. It is submitted that claims 1 and 40 define patentable subject matter and are allowable.

The Examiner also asserted that the phrase "force aligned in the first direction" is indefinite. Again, Applicants disagree but has amended claims 1 and 40 to recite "force is applied to the ear in said first direction." Such amendment is being made in order to bring this case closer to allowance. The Examiner suggested that no support in the specification for the above-cited claim limitation. However, Applicants submit that the specification provides adequate support for the above-identified amendment of claims 1 and 40, including, for example, paragraphs [0046] and [0047] and Figures 1, 3 and 6-8 of the specification.

With regard to the Section 112 rejection of claim 41, Applicants note that none of the above-cited phrases that the Examiner asserted as indefinite are recited in claim 41. Applicants presume that the Examiner erred in rejecting claim 41 under Section 112. However, if the Examiner maintains such rejection, Applicants request the Examiner indicate which phrase in claim 41 the Examiner believes is indefinite.

For all of the above reasons, Applicants respectfully request reconsideration and withdrawal of the Section 112 rejection of claims 1-20, 40 and 41.

The Examiner has rejected claims 1-12 and 15-20 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,648,315 to Yung Jen Lee ("Lee") in view of U.S. Patent No. 2,424,313 to Robert O. Heinrich ("Heinrich") and U.S. Patent No. 6,279,431 to Seber et al. ("Seber").

Applicants traverse such rejection.

Applicants submit that the Examiner can only combine the disclosures of Lee with Heinrich if such combination is obvious to one skilled in the art. However, Lee and Heinrich are two non-combinable references. In support of this position, Applicants first submit the apparent practical difficulties of making the substitution suggested by the Office Action while maintaining the essential functions of both devices. Indeed, the clamping lever in Heinrich is not a brake release; it is a clamping device. This lever of Heinrich functions to only lock the rod when the rod is in place. Thereafter, the lever forces the jaws to close more, thereby further clamping onto any materials held by the jaws. This lever can then be pulled to release the materials held.

However, this lever of Heinrich is a completely different device than a knob (as taught by Lee) that is used solely for releasing the release panel of Lee. Indeed, the release panel of Lee is always engaged in the lock position and only is in the unlock position when the knob is pressed. Clearly, this is opposite of Heinrich. The release panels in Heinrich are always in the release position until the clamping lever locks the rod in place. With the combination of Lee and Heinrich, will the release panel always be in the lock position or always be in the release position without action by the user? If the release panel is always in the lock position, then the rod cannot freely slide without action by the user, as required by Heinrich (see Heinrich, column 3, lines 15-20). If such release panel is always in release position (without actuation required by the user), then the handgrip and the catch plate of Lee no longer operate as intended (see Lee, column 3, line 64 – column 4, line 13). Indeed, the handgrip and the catch plate are an integral parts of Lee's invention. Additionally, the catch plate would still not allow for the rod to slide in both directions and Heinrich requires the rod to be "easily slid back and forth" (see Heinrich, column 3, lines 18-19). Clearly, the combination of Lee and Heinrich suggested by the Examiner is

practically unworkable and would eliminate an essential function of Lee. This is partly due to the fact that the Examiner is trying to substitute a release lever with a clamping lever. Applicants would like to remind the Examiner that the Examiner cannot simply pick and choose pieces from any one reference to make the present invention; instead, the Examiner must consider each invention as a whole when combining references.

Secondly, not only does the prior art not teach or suggest such a combination, the prior art actually contains matter "teaching against" such a combination. Lee describes a device that allows the handgrip to clamp materials disposed between the jaws via a step-by-step process. This is done by engaging a pawl and having a release panel that clamps the rod at every step, allowing for very tight clamping of the material. This is the essential invention of Lee – even listed in the title, "Clamping Device Having an Indirect Driving Mechanism." However, Heinrich obviously teaches away from allowing the release panel or catch plate to be engaged while the rod is being slid. Instead, Heinrich teaches the release plate and catch plate must not engage the rod so that the rod is "easily slid back and forth" (see Heinrich, column 3, lines 18-19). Clearly this teaches away from combining Lee and Heinrich.

Third, Applicants submit that even if the references are somehow combined, as suggested by the Examiner, the resulting combination would not operate as intended or would be rendered inoperable – rendering such combination improper. On page 2 of the Office Action, the Examiner stated, "[t]o fashion th[e] ear [of Lee] such that it extends through a slot or hole in the side of the handle would have been obvious . . ." However, if one moved the knob 42 (and corresponding slot) of Lee to the side of the handle, as suggested by the Examiner, the knob 42 would no longer actuate the release panel. This is because the knob 42 can only actuate the release panel if the knob is orientated in a direction parallel to the direction that the release panel can move – both of which must be along the same direction as the rod 20. When the knob and the release panel are orientated in the same direction, as required in Lee, the knob can then exert a force against the face of the release panel, thereby moving the release panel (see Figures 3-4 of Lee). However, if the knob was placed on the side of the handle of Lee, as suggested by the Examiner (via a combination of Lee and Heinrich), the knob and the release panel would then be

perpendicular to each other, thereby not allowing the knob to exert a force against the face of the release panel. If no force is exerted to the face of the release panel, the release panel will not release the rod, rendering the combination of Lee and Heinrich "inoperable for its intended purpose."

Further, it is submitted that the combination of Lee and Heinrich is based on the use of impermissible hindsight and is only obvious if Applicants' disclosure is used as a template for the combination. One factor to consider is whether there is a teaching or suggestion to combine the references as proposed by the Examiner. In the present case, there is no such teaching or suggestion in either Lee or Heinrich and it is submitted that one skilled in the art would not have found the combination of references obvious without benefit of the instant disclosure. One skilled in the tool art would clearly not have resorted to the clamping lever of Heinrich to be a brake release for the clamp in Lee.

Applicants submit that even if Lee is combined with Heinrich, as suggested by the Examiner, the resulting combination would still not teach all of the claimed elements. For example, on page 2 of the Office Action, the Examiner stated that:

"Lee shows an ear 42 that is capable of being actuated from the front and the side of the handle. To fashion this ear such that it extends through a slot or hole in the side of the handle would have been obvious for one skilled in the art at the time the invention was made in view of the disclosure of Heinrich."

Applicants disagree. As previously discussed, Applicants submit that the knob 42 of Lee is only capable of being actuated from the front of the handle, as shown in Fig. 1 of Lee. Nowhere does Lee disclose that the knob 42 is actuated anywhere other than depressing the knob from the front of the handle. This is because the knob 42 of Lee only extends toward the front of the handle and no portion of the knob 42 of Lee extends to the side of the handle.

Applicants also submit that there is no disclosure in Lee of a slot that faces in a direction that is substantially perpendicular to the support element. The only slot in Lee faces in a direction that

is parallel to the rod 20 to provide access to knob 42. The Examiner looked to Heinrich to remedy such deficiency in Lee by taking the position that the lever 40 in Heinrich "extends through a hole or slot in the side of housing . . . as particularly shown in Figure 2 of Heinrich." (see Office Action, page 2). Applicants presume that the Examiner is misinterpreting the lever 40 as extending through the shell 18 of Heinrich (see Figure 2 of Heinrich). However, lever 40 in Heinrich does *not* extend through any housing (e.g. shell 18) and instead is connected (i.e. welded) to the shaft 34, as is clearly illustrated in Figure 1. The only device extending through the shell 18 of Heinrich is shaft 34 and not lever 40. Additionally, neither the shaft nor the lever in Heinrich can be reasonably interpreted as an ear as is used in the present application.

Further, the Examiner stated on page 3 of the Office Action that "a pin or the like can be fixed onto the side of ear 42 of Lee . . . as broadly taught by the slot and pin 242, 246 in the handle of Seber." Applicants first submit that the slider pin 246, contact surface 242 and slot 248 of Seber are parts of an overcenter lock mechanism 240 for self-adjusting pliers. However, the overcenter lock mechanism 240 of Seber does not make contact with any braking lever. Applicants are at a loss as to how the pin 246 and slot 248 of Seber would be implemented into Lee, especially since the pin 246 and slot 248 of Seber is specifically designed for pliers as an overcenter locking mechanism. There is clearly no suggestion in Seber for one to take the overcenter locking mechanism 240 of Seber and somehow connect it to the knob 42 of Lee. This idea is nonsensical and one skilled in the art would simply not have any motivation to combine the pin and slot of Seber with the knob of Lee. As such, Applicants submit that the Examiner is using impermissible hindsight to reconstruct Applicants invention using the Applicants' claims as a template.

Additionally, claims 1 and 40 recite that the ear is actuated via a force applied to the ear in the same direction as the direction which the support member moves to *open* the clamping jaw by moving the clamping jaw away from a second clamping jaw. Lee does not teach such limitation. In fact, Lee teaches away from this limitation because the knob 42 of Lee is actuated by depressing the knob in the same direction as the direction which the rod moves to *close* the clamping jaw by moving the clamping jaw towards a second jaw. This direction in Lee is the

opposite direction as the direction of forced actuation in claims 1 and 40.

Applicants respectfully submit that Lee, Heinrich and Seber do not render independent claim 1 obvious and thus, claim 1 is submitted to be allowable. Claims 2-20 depend from claim 1 and thus, are also allowable for the same reasons claim 1 is allowable.

The Examiner has rejected claims 13-14 under 35 U.S.C. §103(a) as being unpatentable over Lee in view of Heinrich and Seber and further in view of U.S. Patent Number 707,680 to De Worth.

In rejecting claims 13-14, the Examiner stated that trapezoidal cams are well known and obvious and cited De Worth. Applicant disagrees and submits that De Worth does not disclose a trapezoidal cam. The Examiner points to the clamping wedge 11 of De Worth, but this is a wedge and not a cam. Applicants respectfully submit that the Examiner has simply not made a *prima facie* case of obviousness for claims 13-14. Additionally, claims 13-14 depend from claim 1 and are allowable for the same reason that claim 1 is allowable. Withdrawal of the rejection of claims 13-14 is respectfully requested.

The Examiner has rejected claims 40 and 41 under 35 U.S.C. § 103(a) as being unpatentable over Lee in view of Heinrich and Seber and in further view of U.S. Patent No. 5,853,168 to Johannes Drake ("Drake"). Applicants respectfully traverse such rejection.

Claim 40 recites that the ear is actuated via a force that is applied to the ear in substantially same direction as the direction that the support member moves in order to open the clamping jaw. Drake clearly shows the release lever is actuated in a direction that is *opposite* to the direction which the slide bar opens the movable jaw. Neither Lee, Heinrich nor Seber disclose an ear that actuates the brake lever via the same direction that the support member "moves to allow the first clamping jaw to move away from a second clamping jaw," as recited in claim 40. Thus, for at least the above reasons, the combination of Lee, Heinrich, Seber and Drake does not disclose every element of claim 40 and thus, claim 40 is allowable.

With respect to claim 41, claim 41 recites that the ear is only capable of actuation from the side of the clamp body. The lever in Drake is only capable of actuation from the top of the clamp body and cannot be actuated from the side of the clamp body. Further, the lever in Drake does not translationally move from one edge of the slot to the opposite side of the slot, as recited in claim 41. Instead, the lever in Drake moves from the middle of the slot to one edge of the slot (see lever 25 in opening 44 of Figure 1 of Drake). Neither Lee nor Heinrich disclose either of the above-recited limitations. The Examiner has also not addressed either of the above-recited claim limitations whatsoever. Thus, for at least the above reasons, it is submitted that the combination of Lee, Heinrich, Seber and Drake does not disclose every element of claim 41 and thus, claim 41 is allowable.

The Examiner has not addressed the above ear actuation limitations of claims 40-41 in the Office Action, but instead stated that the “directions specified in the claim are seen to be the same directions disclosed in the references.” Applicant vigorously disagrees. Again, Applicants have indicated the direction of force applied to the ear and such direction is completely opposite than that disclosed in the cited art. Further, the Examiner indicated that the direction of the actuation is a mere “design choice.” Applicants strongly disagree and submit that the direction of actuation of the ear is critical for operation of the brake lever according to at least one embodiment of the invention. Indeed, Applicants submit that Applicants’ invention as well as the inventions in the cited art would be rendered inoperable if the direction of actuation is reversed. As such, the direction of actuation of the ear cannot be a mere design choice, as suggest by the Examiner.

Further, Applicants submit that Drake cannot be combined with Lee, Heinrich and Seber. Such combination would certainly render Lee inoperable because the lever in Drake is a braking lever that directly contacts the slide bar and the lever in Heinrich is a clamping device – neither of which are brake releases. If the lever in Heinrich or Drake is inserted into Lee, the levers would not release the brake release of Lee, rendering Lee inoperable. Further, Seber merely relates to pliers and an overcenter locking mechanism, which cannot be implemented into Lee, as previously discussed. Thus, it is improper to combine Drake with Lee, Heinrich and Seber.

For at least the above reasons, it is submitted that independent claims 40-41 define over the art relied on by the Examiner and are allowable.

Applicants believe they have responded to the Examiner's concerns, and that the application is in condition for allowance. Reconsideration of this application as amended is hereby requested.

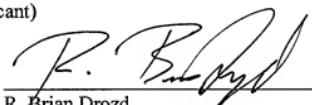
**Conclusion**

In view of the foregoing amendments and remarks, Applicants submit that all claims are now in condition for allowance. Accordingly, allowance of such claims is respectfully requested. If the Examiner has any questions about the present Amendment a telephone interview is requested. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 13-4365.

Respectfully submitted,

Anthony B. Fuller

(Applicant)



Date: 1/8/09

By:

R. Brian Drozd

Registration No. 55,130

Moore & Van Allen, PLLC

P.O. Box 13706

Research Triangle Park, NC 27709

Telephone: (919) 286-8000

Facsimile: (919) 286-8199